REMARKS

I. Status of the Claims

Claims 1-20 are canceled. Claims 21-28 were new, and are now pending in this case. Of claims 21-28, no claims are amended, and no claims are canceled.

II. Claim Rejections

1. Claims 21-28 stand rejected under the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent 6,739,506.

2. Claims 21-22 stand rejected under 35 USC § 102(b) as being anticipated by Yan et al., U.S. 2002/0152116.

3. Claims 23 and 25 stand rejected under 35 USC § 103(a) as being unpatentable over Yan, U.S. 2002/0152116, in view of Shurling et al., U.S. Patent 6,009,415.

4. Claims 24 and 26-28 stand rejected under 35 USC § 103(a) as being unpatentable over Yan, U.S. 2002/0152116, in view of Shurling et al., U.S. Patent 6,009,415, and further in view of Selgas et al., U.S. Patent 6,571,290.

III. ARGUMENT

A. Double Patenting

Claims 21-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent 6,739,506 (the '506 patent). Accompanying this response is a Terminal Disclaimer to Obviate a Double Patenting Rejection over a Prior Patent, thereby rendering moot the double patenting rejection of claims 21-28.

B. Yan

Claims 21-22 stand rejected under 35 USC § 102(b) as being anticipated by Yan et al., U.S. 2002/0152116. Applicant respectfully traverses this rejection.

"A claim is anticipated only if each and every element

as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053, (Fed. Cir. 1987). Also, "All words in a claim must be considered in judging patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494. 496 (CCPA 1970). Furthermore, section 102 is designed to specifically exclude from patentable subject matter anything this is considered old. To successfully combat a prima facie case of anticipation, the Appellant must show that not all elements of prima facie anticipation have been met. The Federal Circuit endorsed this view in *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 at 1444 (Fed. Cir. 1992) stating "[i]f the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the Appellant is entitled to grant of the patent." According to the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 22 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983))(emphasis added).

Independent claim 21

Yan teaches an authorized user of a credit card who incurs debts on the card. The authorized user is provided with an award, i.e., a dynamically generated rebate, fixed rebate) that represents an opportunity to recover a portion of the total amount of the incurred debts. Authorized users can select between a fixed rebating state of operation, or a dynamic rebating state of operation. In a fixed rebating state of operation, fixed rebates are applied to transactions or accounts, which allows the authorized user to recover a portion of an incurred debt relating to transactions or accounts. In a dynamic rebating state of operation, a deep sweepstake rebate engine dynamically selects transactions or accounts to receive a specified rebate, and/or dynamically generates varying rebates for each customer and/or each transaction. Like the fixed rebate state of operation, the dynamic rebate state of operation provides customers with a mechanism to recover a portion of an incurred debt relating to transactions or accounts.

In the dynamic state of operation, the programs provide for dynamically-generated rebate amounts to be drawn by the participating customer. The possibility of

chance of obtaining a favorably large rebate amount creates a sweepstake-like marketing effect, and induces customers to purchase a range of products and services using the corresponding credit card of the sponsoring credit card issuer.

In independent claim 21, the claimed method includes providing an authorized user of a credit card issued by a service provider; the authorized user incurring debt on the credit card; and for a predetermined amount of debt incurred by the authorized user on the credit card, the service provider submitting an entry into a sweepstakes on behalf of the authorized user. According the method set forth in claim 21, in response to an authorized user incurring debt on the credit card, the service provider submits an entry into a sweepstakes on behalf of the authorized user.

In Yan, a service provider does not submit an entry into a sweepstake on behalf of an authorized user in response to the authorized user repaying an amount of a debt incurred on a credit card. Yan provides rebates to customers for allowing them to recover a portion of an incurred debt. The rebate can be a fixed rebate selected

by the customer, or a dynamic rebate. According to the dynamic rebate state of operation, a series of the customer transactions are selected randomly, and a rebate is generated randomly for each eligible transaction, which characterizes the "sweepstake-like" marketing effect. In Yan, the service provider does not make an entry into a sweepstake on behalf of the authorized user, and nowhere does Yan teach making an entry into a sweepstake. Rather, Yan provides customers with rebates for incurred debts, which are fixed as selected by the customer, or randomly selected by a dynamic rebate selection engine. Accordingly, Yan does not teach of each and every element specified in applicant's independent claim 21, and the section 102 rejection of claim 21 is believed to be moot and should be withdrawn.

Dependent claim 22

Claim 22 is dependent upon a claim that is allowable according to the argument set forth above and, therefore, is allowable.

C. Yan and Shurling et al.

Claims 23 and 25 stand rejected under 35 USC § 103(a) as being unpatentable over Yan, U.S. 2002/0152116, in view of Shurling et al., U.S. Patent 6,009,415. Applicant respectfully traverses this rejection.

Dependent claims 23 and 25

Claims 23 and 25 are dependent upon a claim that is allowable according to the argument set forth above and, therefore, each of them is allowable.

D. Yan, Shurling et al., and Selgas et al.

Claims 24 and 26-28 stand rejected under 35 USC § 103(a) as being unpatentable over Yan, U.S. 2002/0152116, in view of Shurling et al., U.S. Patent 6,009,415, and further in view of Selgas et al., U.S. Patent 6,571,290. Applicant respectfully traverses this rejection.

Dependent claims 24 and 26-28

Claims 24 and 26-28 are dependent upon a claim that is allowable according to the argument set forth above and, therefore, each of them is allowable.

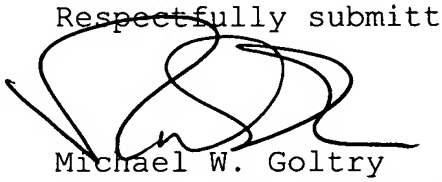
E. Conclusion

Pursuant to the foregoing, Applicant believes that the rejection of independent claim 1 is not supported by the prior art of record in this case, and that the rejection thereof and the rejections of the corresponding dependent claims are moot and should be withdrawn. Accordingly, Applicant traverses each and every rejection set forth in Paper No. 060218. Any particular rejection not specifically addressed is not to be deemed to be Applicant's agreement with, or Applicant's acquiescence to, the Examiner's position or interpretation of the prior art. It is to be understood that Applicant's present response is for the purpose of overcoming the rejections of the subject matter set forth in the pending independent claims, in which the subject matter claimed therein is presently desirable to Applicant in the present application.

In view of the foregoing, Applicant submits that the invention disclosed and claimed in this application is patentable and not anticipated or obvious over the prior art of record in this case. Therefore, allowance of the present application is in order and respectfully requested.

Date: 11/29/2006

Respectfully submitted,



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